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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,678	12/03/2004	Mitsutoshi Shinkai	450100-05033	6633
7590 William S Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				
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EXAMINER				
DANG, HUNG Q				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/516,678

**Applicant(s)**

SHINKAI ET AL.

**Examiner**

HUNG Q. DANG

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's amendments filed 06/30/2008 with respect to amended claims 9 and 10 have been fully considered but are found not to overcome 35 U.S.C. 101 rejections.

Currently amended claim 10 recites, "a computer readable medium" in which only data are recorded. Although data are recorded on a computer-readable medium, pure data do not impart functionality to a computer or computing device, and are thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se. Thus, amended claim 10 does not overcome the 35 U.S.C. 101 rejection of nonfunctional descriptive materials.

Applicant's arguments with respect to 35 U.S.C. 102 and 103 rejections have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 10 recites series of data recorded on a computer-readable medium. However, pure data do not impart functionality to a computer or computing device, and

are thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 and 6-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Brook et al. (US 2003/0146915) and Tezuka et al. (US Patent 5,206,850).**

Regarding claim 1, Brook et al. disclose a recording control apparatus for controlling recording of first, second, and third data series onto a storage medium ([0277], [0280], [0282], [0151], and [0290]), the apparatus is characterized by comprising: first data extracting means for extracting data having a first data amount from the first data series ([0277]), the first data amount being a data amount in accordance with a data amount required for reproduction for first reproduction time ([0277] with first reproduction time being the reproduction time of the media data); second data extracting means for extracting data having a second data amount from the second data series, the second data amount being a data amount in accordance with a data amount required for reproduction for second reproduction time that is different from the first reproduction time ([0280], [0282]); first recording-control means for performing

recording-control to record data having the first data amount for the first data series and data having the second data amount for the second data series onto the storage medium so that the respective data are periodically arranged ([0277], [0280], [0282]; Fig. 22; [0307]; Fig. 28); and second recording-control means for performing recording-control to record the third data series onto the storage medium so that the third data series is arranged at random independently of the first data series and the second data series ([0290]).

However, Brook et al. do not disclose the storage medium to be an optical disk and the data are arranged in a circumferential direction of the optical disk in a form of annular rings.

Tezuka et al. disclose a storage medium to be an optical disk and the data are arranged in a circumferential direction of the optical disk in a form of annular rings (Fig. 1; column 1, lines 15-42; column 3, lines 29-33; column 6, lines 30-37).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the optical disk disclosed by Tezuka et al. into the recording control apparatus disclosed by Brook et al. because optical disks such as CD and DVD are very popular recording medium that conveniently provides portability and large capacity for storage.

Regarding claim 6, Brook et al. also disclose the first data series is a data series of video or a data series of audio associated with the video ([0277], [0280]); the second data series is a data series of metadata that requires a real-time characteristic for the data series of video or the data series of audio associated with the video ([0280],

[0282]); and the third data series is a data series of metadata that does not require a real-time characteristic for the data series of video or the data series of audio associated with the video ([0151], [0290]).

Regarding claim 7, Brook et al. also disclose for each clip that constitutes the material data in a predetermined area in the first data series, the third data series uses one file containing one of at least an LTC/UMID, GPS data, front-end time code, discontinuous-point time code information, a front-end extended UMID source pack, and a discontinuous-point extended UMID source pack ([0151]).

Claim 8 is rejected for the same reason as discussed in claim 1 above.

Claim 9 is rejected for the same reason as discussed in claim 1 above.

Claim 10 is rejected for the same reason as discussed in claim 1 above.

**Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brook et al. (US 2003/0146915) and Tezuka et al. (US Patent 5,206,850) as applied to claims 1 and 6-10 above and further in view of David (US 2002/0131763).**

Regarding claim 2, see the teachings of Brook et al. as discussed in claim 1 above. However, Brook et al. do not disclose the first data amount is a data amount that is an integral multiple of a data amount in a physical unit area of the storage medium and that is close to a data amount required for reproduction for the first reproduction time; and the second data amount is a data amount that is an integral multiple of a data amount in the physical unit area of the storage medium and that is close to a data amount required for reproduction for the second reproduction time.

David discloses the first data amount is a data amount that is an integral multiple of a data amount in a physical unit area of the storage medium and that is close to a data amount required for reproduction for the first reproduction time ([0040]; [0008], [0009], [0046], [0047]); and the second data amount is a data amount that is an integral multiple of a data amount in the physical unit area of the storage medium and that is close to a data amount required for reproduction for the second reproduction time ([0010], [0040]; [0046], [0047]).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of David into the recording control apparatus disclosed by Brook et al. because, according to David, the taught feature can facilitate the reading, writing, and modifying of the data ([0012]).

Regarding claim 3, David also discloses the physical unit area is a minimum area to/from which data writing/reading is performed or an area in which an ECC block on which ECC processing is performed is recorded ([0008], [0009], [0010]).

Regarding claim 4, David also discloses the first recording-control means causes the data having the first data amount for the first data series and the data having the second data amount for the second data series to be recorded onto the storage medium so that boundaries of the respective data match boundaries of physical unit areas of the storage medium ([0008], [0009], [0010], [0041], [0042]).

Claim 5 is rejected for the same reason as discussed in claim 3 above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. DANG whose telephone number is (571)270-1116. The examiner can normally be reached on IFT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HUNG Q DANG/  
Examiner, Art Unit 2621

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621